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10/820,411	04/08/2004	Dale W. Malik	190253-1040	7811

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EXAMINER

FILIPCZYK, MARCIN R

ART UNIT	PAPER NUMBER
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2163

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08/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/820,411

Applicant(s)

MALIK, DALE W.

Examiner

Marc R. Filipczyk

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is responsive to Applicant's RCE request and amendment filed on June 28, 2007.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/28/2007 has been entered. Claims 21-40 are pending.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the invention accomplishes a practical application and whether it generates a useful, concrete and tangible result.

The guidelines explain that a practical application of a 35 U.S.C. 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.

In the present case, independent claims 21, 28 and 35 do not involve transformation of article or physical object to a different state or thing, they merely recite searching data. Further, independent claims 21, 28 and 35 do not produce a useful, concrete, and tangible result, but merely search data to obtain a result so that a score is assigned to the result, however, no data or results are stored for usefulness and reusability. State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02.

Claims 21, 28 and 35 taken as a whole are directed to a mere method and system, i.e., to only its description or expression, an abstract idea, do not comprise a practical application as explained above hence are nonstatutory.

Since the claimed invention, as a whole, does not comprise a practical application as explained above, claims 22-27, 29-34 and 36-40 which depend from claims 21, 28 and 35 respectively, are deemed to be directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2163

Claims 23-25, 30-32 and 37-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As to claims 23-25, 30-32 and 37-39, the limitation of “determine, from the combined score, a risk...” was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There are no teachings of or criteria that account for a complete and useful implementation of a combined score to determine risk.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-25, 30-32 and 37-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 23-25, 30-32 and 37-39, the phrase “risk” is indefinite. The metes and bounds of risk are not clear. There are no teachings of such as an algorithm or function or criteria that account for or teach a complete and useful implementation of a combined score to determine any risk.

***Claim Rejections - 35 USC § 103***

Art Unit: 2163

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-40 rejected under 35 U.S.C. 103(a) as being unpatentable over Woods (U.S. Patent No. 6,101,491) in view of Clark et al. (herein Clark) (U.S. Publication No. 2004/0153663).

Regarding claims 21, 28 and 35, Woods teaches a system, medium method and program comprising (fig. 1 and abstract):

means for searching for a first piece of sensitive information (fig. 1, items 120, 130 and *query & parameters*);

means for searching for a second piece of sensitive information (figs. 1 and 4, items 130 and 410);

means for obtaining a result for the first piece of sensitive information (fig. 1, items 120, 130, 140 a,b and *hits*);

means for obtaining a result for the second piece of sensitive information (fig. 1, items 120, 130, 140 a,b and *hits*);

means for assigning a first score to the first item of information (figs. 1 and 5, item 530, also see figs. 1 and 4, items 120, 130, 140a,b, 410-440 and *scores*);

means for assigning a second score to the second item of information (figs. 1 and 5, item 530); and,

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means for assigning a third score to the sensitive information, the third score being a function of the first score and the second score (fig. 5, items 540, 550 and 560, and col. 9, lines 19-35, *merge hits & scores and results*).

means for providing the third score to a user (fig. 5, items 540, 560 also see figs. 1 and 6), but Woods fails to teach to determine a risk for at least one identity related vulnerability.

However, Clark teaches analyzing and comparing data to determine a relative fraud risk (abstract and figures 1 and 2, and related text, Clark). Therefore, it would have been the ordinary skilled artisan's assessment that it would have been obvious to use Clark's analyzing method in Woods system to identify related vulnerability (abstract and figures 1 and 2, and related text, Clark). One of ordinary skill in the art would have been motivated to combine Woods with Clark because both systems search, analyze and compare data.

Regarding claims 22, 29 and 36, Woods and Clark discloses sensitive information includes one of: a name, an address, a social security number and telephone number and an email address (see fig. 2, item 250 and related text, Woods).

Regarding claims 23-25, 30-32 and 37-39, Woods and Clark disclose the combined score can be used for a number of analysis, including potential risks (fig. 2, all the elements and item 90, and related text, Clark).

*(Note: related query hits and scores are used based on user/client application and include many uses in security applications)*

Regarding claims 26, 27, 33, 34 and 40, Woods and Clark disclose the piece of sensitive information is configured to search web pages (col. 6, lines 46-48, Woods).

***Response to Arguments***

Applicant's amendment and remarks submitted on June 28, 2007 have been fully considered but they are not persuasive. The arguments and responses are listed below:

Applicant argues on page 8 that "providing the combined score to a user" is statutory.

Examiner disagrees. A useful, concrete, and tangible result that could be reused is not generated. Please refer to the rejections above for more information.

Applicant argues on pages 8 and 9 that "three areas of vulnerability are shown" thus the method is enabling.

Examiner disagrees. Applicant's disclosure does not teach criteria that account for a complete and useful implementation of a combined score to determine risk. There are no teachings of an algorithm or function or criteria that account for or teach a complete and useful implementation of a combined score to determine any risk.

Applicant contends that the amended independent claims are allowable over Woods because Woods does not teach "determining... a risk".



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Examiner disagrees. The argued limitation is not disclosed in the specification that would teach a complete and useful implementation of a combined score for determining a risk. Second, Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

With respect to all the pending claims 21-40, Examiner respectfully traverses Applicant's assertion based on the discussion and rejection cited above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF

August 9, 2007



**WILSON LEE**  
**PRIMARY EXAMINER**